

Appl. No.: 09/928,682
Amdt. dated 11/30/2005
Reply to Office action of August 30, 2005

NOV 30 2005

REMARKS/ARGUMENTS

The Applicant respectfully requests consideration of the present application in view of the preceding amendments to the claims and the following remarks, which are responsive to the non-final Office Action mailed August 30, 2005.

As noted in the Office Action, Claims 1-11 and 13-16 are pending in the application, Claims 15 and 16 have been withdrawn from consideration, and Claims 12 and 17 have been cancelled by prior amendment. In the Office Action, the Examiner rejected Claims 1-11 and 13-14 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In addition, the Examiner stated that "[a]ll of the [35 U.S.C. §§] 102 and 103 rejections made in the Office action mailed November 4, 2004 are maintained." The § 112, first paragraph rejection and the §§ 102 and 103 rejections that were presented in the November 4, 2004 Office Action are addressed below.

I. Rejection of Claims 1-11 and 13-14 under 35 U.S.C. § 112, first paragraph

On page 2 of the Office Action mailed August 30, 2005, the Examiner rejected Claims 1-11 and 13-14 under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement. In particular, the Examiner asserts that the following language added to Claim 1 in response to the Office Action mailed November 4, 2004 is new matter: "the first and second container portions having no passageway therebetween."

The Applicant appreciates the Examiner's careful review of the application. In addition, the Applicant thanks the Examiner for the telephone conference held on November 22, 2005, during which the attorney for the Applicant discussed this language with the Examiner. In light of the Examiner's understanding, the Applicant has removed the above language from Claim 1. The Applicant has also amended Claim 1 to specify that the container does not include a passageway that (1) extends between the interior of the first container portion and the interior of the second container portion and (2) facilitates communication of a fluid between the interior of the first container portion and the interior of the second container portion. The Applicant believes this amendment is supported by the specification and the figures as originally filed. For example, Figures 1 and 4 show an embodiment in which the first and second container portions

Appl. No.: 09/928,682
Amdt. dated 11/30/2005
Reply to Office action of August 30, 2005

are connected by the connecting portion only, and the connecting portion is shown and described as having a solid cross-section throughout. Thus, in this embodiment, because there is no passageway extending between the interior of the first container portion and the interior of the second container portion, and because the container portions are only connected via the connecting portion, which is solid, fluid cannot flow between the interior of the first container portion and the interior of the second container portion.

II. Rejection of Claims 1-17 under 35 U.S.C. § 102(b)

On page 2 of the outstanding Office Action mailed August 30, 2005, the Examiner maintained all of the rejections made under 35 U.S.C. § 102 presented in the previous Office Action mailed November 4, 2004. On pages 3-6 of the Office Action mailed November 4, 2004, the Examiner made the following rejections under § 102(b):

A) Claims 1-6, 8, and 11-16 were rejected as being anticipated by U.S. Patent No. 3,957,653 to *Blecher*.

B) Claims 1-4, 12-15, and 17 were rejected as being anticipated by U.S. Patent No. 4,799,925 to *Rosenblatt*.

C) Claims 1-3, 5, 6, 11-13, and 15-17 were rejected as being anticipated by U.S. Patent No. 5,803,268 to *Levy*.

D) Claims 1-3, 5-7, 9, 12-15, and 17 were rejected as being anticipated by U.S. Patent No. 4,603,784 to *Chang*.

E) Claims 1, 3, 5, 6, 11, and 12 were rejected as being anticipated by U.S. Patent No. 2,611,499 to *Mayer*.

F) Claims 1, 4-6, and 12 were rejected as being anticipated by U.S. Patent No. 3,676,076 to *Grady*.

G) Claims 1, 4-6, and 11-17 were rejected as being anticipated by U.S. Patent No. 4,187,951 to *Cambio Jr.*

The Applicant again thanks the Examiner for the thorough review of the application. The Applicant has amended the claims, and in light of the amendments made to independent Claim 1 in this paper and in the response dated May 4, 2005, which was filed in response to the Office

NOV 30 2005

Appl. No.: 09/928,682
Amdt. dated 11/30/2005
Reply to Office action of August 30, 2005

Action mailed November 4, 2004, the Applicant respectfully asserts that independent Claim 1 as currently amended is not anticipated by the prior art references cited above. In particular, the prior art references cited above do not disclose or suggest, for example, (a) a second container portion having an opening at the top that has a width that is at least as wide as the largest interior width of the second container portion, (b) a second container portion having an exterior that is spaced apart from an exterior of a first container portion via a connecting portion, (c) a second container portion having an exterior that is fixedly connected to an exterior of a first container portion solely along a length of a single side of the exterior of the second container portion that faces the exterior of the first container portion by the connecting portion, and/or (d) a container that does not include a passageway that (i) extends between the interior of the first container portion and the interior of the second container portion and (ii) facilitates communication of a fluid between the interior of the first container portion and the interior of the second container portion, as required by amended Claim 1. Thus, the Applicant respectfully asserts that Claim 1 is not anticipated by the prior art references cited above.

Dependent Claims 2-11 and 13-14 depend from independent Claim 1 and include all of the limitations of Claim 1. Accordingly, for this reason and for the reasons stated above with respect to independent Claim 1, dependent Claims 2-11 and 13-14 are patentable over the prior art. Independent Claim 15 and dependent Claim 16 have been withdrawn from consideration, and dependent Claims 12 and 17 have been cancelled from the application.

III. Rejection of Claims 1-17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,889,255 to Schiemann in view of Grady and Cambio Jr.

On page 2 of the outstanding Office Action mailed August 30, 2005, the Examiner maintained all of the rejections made under 35 U.S.C. § 103 presented in the previous Office Action mailed November 4, 2004. On pages 6-7 of the Office Action mailed November 4, 2004, the Examiner rejected independent Claim 1 and dependent Claims 4-17 under § 103(a) as being unpatentable over U.S. Patent No. 4,889,255 to *Schiemann* in view of *Grady* and dependent Claims 2 and 3 under § 103(a) as being unpatentable over *Schiemann* in view of *Grady* and *Cambio Jr.*

Appl. No.: 09/928,682
Amdt. dated 11/30/2005
Reply to Office action of August 30, 2005

The Applicant respectfully asserts that independent Claim 1 as amended is not obvious in light of *Schiemann* in view of *Grady*. According to MPEP § 2142, the burden of establishing a prima facie case of obviousness lies with the Examiner. To establish a prima facie case of obviousness, the following three criteria must be met:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure.

See MPEP § 2142. Furthermore, according to MPEP § 2142:

To reach a proper determination under 35 U.S.C. § 103, the examiner must step backward into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made. In view of all the factual information, the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person. ... [I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of facts gleaned from the prior art.

According to the Examiner, "*Schiemann* discloses a first container portion 12, a second container portion 13 and a connecting portion 18. *Schiemann* discloses the invention except for the absence of a neck or shoulder on the top of the second portion. *Grady* discloses a first portion 101 and a second portion 114 with no shoulder or neck It would have been obvious to modify *Schiemann* to include another compartment or to modify the second compartment to be a tool compartment as motivated by the *Schiemann* teaching of storing tools."

The Applicant respectfully disagrees with the Examiner's proposed combination of references. In particular, *Schiemann* discloses a dual purpose can that includes two chambers that each include a threaded neck, and the outer wall of one of the chambers defines four projections that are closely spaced so that a tool can be held between the projections. The

Appl. No.: 09/928,682
Amdt. dated 11/30/2005
Reply to Office action of August 30, 2005

projections permit "the forest worker to have his auxiliary tools ready for use at all times without having to carry them on his back or using a separate tool box, etc." See col. 1, lines 34-37.

Grady discloses a container 101 that "consists of ... a scabbard 114," which is integrally formed with the container 101 and "protects the pipette 105 during shipping and storage." See col. 2, lines 53-56 and col. 3, lines 8-10.

The Applicant respectfully asserts that the Examiner impermissibly used hindsight in making the above combination as there is no suggestion or motivation, in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references' teachings at the time when the invention was unknown and just before it was made. In particular, because the container of *Schiemann* already includes the protrusions as a tool-holding means, one of skill in the art would not be motivated to modify the container of *Schiemann* to include a container portion having the features of the scabbard of *Grady*.

Because one of skill in the art would not be motivated to combine or modify the features of *Schiemann* in light of *Grady*, the Applicant respectfully asserts that a prima facie case of obviousness has not been properly established for independent Claim 1. Accordingly, the Applicant respectfully asserts that independent Claim 1 is not obvious in light of *Schiemann* and *Grady*.

Dependent Claims 2-11 and 13-14 depend from independent Claim 1 and include all of the limitations of Claim 1. Accordingly, for this reason and for the reasons stated above with respect to independent Claim 1, dependent Claims 2-11 and 13-14 are patentable over the prior art. Independent Claim 15 and dependent Claim 16 have been withdrawn from consideration, and dependent Claims 12 and 17 have been cancelled from the application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Appl. No.: 09/928,682
Amdt. dated 11/30/2005
Reply to Office action of August 30, 2005

The Applicant appreciates the Examiner's careful consideration of this application and would welcome a telephone conference with the Examiner to expedite the processing of the patent application. Applicant's attorney, Meredith Struby, may be reached directly at (404) 881-4626.

Respectfully submitted,

Meredith W. Struby

Meredith W. Struby
Registration No. 54,474

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Atlanta Office (404) 881-7000
Fax Atlanta Office (404) 881-7777

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the US Patent and Trademark Office at Fax No. (571) 273-8300 on the date shown below.

Meredith Struby
Meredith W. Struby

11-30-05
Date